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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,185	05/03/2001	Jay M. Short	DIVER1280-11	6495

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EXAMINER	
LOEB, BRONWEN	
ART UNIT	PAPER NUMBER
1636	

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/848,185	Applicant(s) SHORT ET AL.	
	Examiner Bronwen M. Loeb	Art Unit 1636	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): *See Continuation Sheet*.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☐ The a)☐ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: *6 and 19*.

   Claim(s) rejected: *1-5,8-18 and 24-26*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☒ Other: *See Continuation Sheet*

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Continuation of 3. Applicant's reply has overcome the following rejection(s): The rejection of claims 1-6, 8-16 and 24-26 under 35 USC §103, the rejection of claims 1-6, 8-19 and 21-28 under 35 USC §112, second paragraph and the rejections have been withdrawn in view of Applicant's amendment.

Continuation of 10. Other: The rejection of claim 1-5, 8-18 and 24-26 under 35 USC §102(e) is maintained because Applicant's arguments are not persuasive. While Thompson et al do teach preparing combinatorial libraries, the main teachings which are the basis for this rejection regard methods of pre-selecting or pre-screening DNA segments prior to making the combinatorial library (see col. 31-32, section 5.1.6, especially col. 31, lines 61-65), not the teachings regarding making the combinatorial libraries themselves. The steps disclosed for this pre-selecting process anticipate the steps recited in the pending claims. Thompson et al clearly teach performing these pre-selection steps on an initial DNA library and that this initial DNA library may contain DNA from one or more species of donor organisms. The donor organisms are disclosed in col. 12-16, section 5.1.1 and specifically include environmental samples which may be uncultured organisms. Use of encapsulation for the pre-screening is disclosed in col. 37-38, section 5.2.3. While Thompson et al's intended use for the enriched DNA may be different from Applicant's, the fact remains that the method to enrich DNA taught by Thompson et al fully anticipates the pending claims. Thus, the rejection is maintained.